



AF JEW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/660,563

Filed: September 12, 2000

Inventor:

Slaughter, et al.

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Examiner: Lesniewski, Victor

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Group/Art Unit: 2152

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Atty. Dkt. No: 5181-64900

Title: Mechanism and Apparatus
for Accessing and
Addressing Services in a
Distributed Computing
Environment

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Robert C. Kowert

Name of Registered Representative

January 18, 2006

Date

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated below.

Claims 1-30 remain pending in the application. Reconsideration of the present case is earnestly requested in light of the following remarks. Please note that for brevity, only the primary arguments directed to the independent claims are presented, and that additional arguments, e.g., directed to the subject matter of the dependent claims, will be presented if and when the case proceeds to Appeal.

The Examiner rejected claims 1-9, 11-19 and 21-29 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,643,650, and claims 10, 20 and 30 over the claims of U.S. Patent Nos. 6,643,650 and 6,789,126. Once the claims have been determined to be otherwise allowable, Applicants will

consider filing a terminal disclaimer in regard to U.S. Patent No. 6,643,650.

The Examiner rejected claims 1-5, 7-15, 17-25 and 27-30 under 35 U.S.C. § 102(e) as being anticipated by Beck et al. (U.S. Patent 6,604,140) (hereinafter “Beck”), and rejects claims 6, 16 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Beck in view of Official Notice. Applicants respectfully traverse these rejections and note the following clear errors in the Examiner’s rejection. **Applicants submit that the Examiner has failed to provide a *prima facie* rejection of independent claims 1, 11 and 21.**

Regarding claim 1, Beck fails to disclose a client reading an advertisement from a space, where the space comprises a network-addressable storage location, wherein the advertisement comprises a Uniform Resource Identifier (URI) and a schema, wherein the URI specifies a network address at which a service may be accessed, and wherein the schema specifies one or more messages usable to invoke one or more functions of the service. Beck teaches a service framework that enables devices to discover and use services over a network. Beck’s service discovery is based on periodic multicasting of service descriptors. Beck teaches that an advertiser retrieves a service to advertise, creates a service descriptor and periodically broadcasts the descriptor (Beck, column 3, lines 59-64 and column 4, lines 40-50). The Examiner cites column 6, lines 1-16 where Beck describes how a client requests usage of a service by querying a service registry. However, Beck does not, either at the cited passage or elsewhere, mention a *client reading an advertisement from a space*. Instead, Beck teaches at the cited passage that a client furnishes a description of the requested service and that the registry matches this request against service descriptors of known services. If a service descriptor in the registry matches the description of the requested service, the registry verifies that the service is already loaded, and if not, loads the service. Beck does not teach that registry returns to the client the service descriptor, which the Examiner contends is an advertisement. Instead, Beck teaches, “[t]he process of binding a service *terminates* in step 507 where a *reference to the service adaptor is returned to the client*” (emphasis added, Beck, column 6, lines 22-24). Elsewhere Beck teaches that a service adaptor “provides an additional level of indirection between clients and the service” and that the service adaptor is a Java class (Beck, column 5, lines 55-61). Thus, a client in Beck’s system requesting usage of service does not read an advertisement from a space, as suggested by the Examiner. Instead, as noted above, the client queries a service registry to obtain a reference to a service adaptor, which cannot be considered an advertisement as defined in claim 1.

Further in regard to claim 1, Beck fails to disclose where the advertisement comprises a Uniform Resource Identifier (URI) and a schema, where the URI specifies a network address at which a service may be accessed, and where the schema specifies one or more messages usable to invoke one or more functions of the service. The Examiner cites column 4, lines 40-60 of Beck. However, the cited passage does not describe an advertisement that includes a schema that specifies messages usable to invoke functions of a service. Beck teaches that a “service descriptor contains information about the service, including the service name and a description of its function.” Beck also states that an “enhanced service descriptor is a service descriptor that also contains the location of the code implementing the service.” (Beck, column 4, lines 45-50). Beck does not describe a service descriptor as including a schema that specifies messages usable to invoke functions of the service. Instead, Beck teaches that a client uses a Java interface for a service to call the methods that the service provides (Beck, column 5, lines 42-46 and column 6, lines 29-36). Beck specifically teaches that a client calls a method provided by the service’s interface. Thus, not only does Beck fail to disclose an advertisement that includes a schema specifying messages usable to invoke functions of the service, Beck describes a Java interface for the service that a “defines the set of operations that the service can perform on behalf of a client” (Beck, column 5, lines 42-43). The service descriptor, which the Examiner equates to the advertisement of Applicants’ claim, clearly does not include a schema specifying messages usable to invoke functions of a service. Moreover, as noted above, Beck’s service descriptor cannot be equated to the advertisement of claim 1 because it is not read by a client from a space, as is explicitly stated in Beck.

Anticipation requires the presence in a single prior art reference disclosure of each and every limitation of the claimed invention, arranged as in the claim. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As discussed above, Beck clearly fails to disclose a client reading an advertisement from a space, wherein the space comprises a network-addressable storage location, wherein the advertisement comprises a Uniform Resource Identifier (URI) and a schema, wherein the URI specifies a network address at which a service may be accessed, and wherein the schema specifies one or more messages usable to invoke one or more functions of the service. Therefore, Beck cannot be said to anticipate claim 1. Thus the rejection of claim 1 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks also apply to claims 11 and 21.

Applicants also assert that the rejection of many of the dependent claims is further unsupported by the teachings of Beck. Applicants will present additional arguments in regard to the dependent claims in an Appeal Brief if necessary.

In regard to claims 6, 16 and 26, the Examiner takes Official Notice that “use of XML as a data representation language in network communications systems was well known.” Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner’s taking of Official Notice in regard to the specific combination of features recited in claims 6, 16 and 26. While the use of XML may have been well known *in other contexts for other purposes*, it was not well known to use XML for expressing messages sent by a client to invoke a service. Pursuant to M.P.E.P. § 2144.03 Applicant asserts that the examiner “must provide documentary evidence in the next Office Action if the rejection is to be maintained.” *See also* 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). The documentary evidence should pertain to the specific limitations recited in 6, 16 and 26, not just XML in general.

Furthermore, the Examiner has failed to provide any motivation whatsoever for combining the teachings of Beck with XML (based on Office Notice) to result in the specific limitations recited in claims 6, 16 and 26. The Examiner merely states, “[s]ince the combination of Beck and Official Notice discloses all of the above limitations, claims 6, 16, and 26 are rejected.” However, obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczaik*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination. As noted above, the Examiner has failed to provide any motivation for combining Beck and the Examiner’s Official Notice of XML.

Furthermore, Beck describes a specific Java interface for the service that a “defines the set of operations that the service can perform on behalf of a client” (Beck, column 5, lines 42-43). To modify Beck to use XML messages would be counter to the intended operation of Beck to

employ a specific Java interface. If a proposed modification would render the prior art feature unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Accordingly, it would be improper to modify Beck's teachings to employ XML messages. Thus, the rejection of claims 6, 16 and 26 is not supported by the prior art and removal thereof is respectfully requested.

In light of the foregoing remarks, Applicant submits the application is in condition for allowance, and notice to that effect is respectfully requested. If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzl PC Deposit Account No. 501505/5181-64900/RCK.

Also enclosed herewith are the following items:

- Return Receipt Postcard
- Notice of Appeal

Respectfully submitted,



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